

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JACQUELINE R. DOYLE and KENNETH F. SHORT

MAILED

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U.S. PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Appeal No. 2006-0522
Application No. 09/364,343

HEARD: March 9, 2006

Before FRANKFORT, MCQUADE, and CRAWFORD, Administrative Patent Judges.

MCQUADE, Administrative Patent Judge.

DECISION ON APPEAL

Jacqueline R. Doyle et al. appeal from the final rejection of claims 1-8, all of the claims pending in the application.

THE INVENTION

The invention relates to "a device in which a unit dose of sterile (USP) saline solution or a sterile water solution is dispensed for the irrigation and cleansing of a wound or incision" (specification, page 1). Representative claim 1 reads as follows:

1. A one-piece sterile non-invasive dispenser for the rapid irrigation and debriding of wounds and incisions, which is disposable in any container, comprising:

a flexible chamber having an internal volume containing a sterile solution, said chamber having an orifice at one end thereof;

a non-invasive nozzle having a first opening at one end and a second opening at the other end thereof, wherein said first opening is affixed to said orifice of said chamber; and said second opening dispenses said solution;

a protective tip affixed to said second opening of said nozzle, thereby maintaining said solution in a sterile state; and a removable packaging band around said protective tip.

THE PRIOR ART

The references relied on by the examiner to support the final rejection are:

Rose	2,135,052	Nov. 01, 1938
Hussey	4,752,288	Jun. 21, 1988
Reddick	4,894,053	Jan. 16, 1990
Wallace et al. (Wallace)	6,066,325	May 23, 2000

THE REJECTIONS

Claims 1 and 3-5 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Hussey.

Claim 2 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Hussey in view of Reddick.

Claim 6 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Hussey in view of Rose.

Claims 7 and 8 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Hussey in view of Wallace.

Attention is directed to the brief (filed February 27, 2004) and answer (mailed January 18, 2005) for the respective positions of the appellants and examiner regarding the merits of these rejections.¹

DISCUSSION

I. Petitionable matter

The appellants (see pages 6 and 10 in the brief) raise as an issue on appeal the 35 U.S.C. § 132 objection to the specification made in the final rejection. This objection, however, is not directly connected to the merits of any rejection of claims. It is therefore reviewable by petition to the Director rather than by appeal to this Board (see In re Henghold, 440 F.2d 1395, 1403-1404, 169 USPQ 473, 479 (CCPA 1971)), and hence will not be further addressed in this decision.

II. The merits

On page 6 in the brief, the appellants state that "[d]ependent claims 2-8 stand or fall with claim 1." This statement coincides with the substantive arguments advanced in the brief and with the intention expressed at the oral hearing by

¹ On page 13 in the brief, the appellants cite the affidavits of Kristen Lavoie and Tomas D. Divinagracia (filed January 30, 2003) to show that the claimed invention fulfills a long-felt need. The record indicates, however, that these affidavits were submitted subsequent to final rejection and refused entry by the examiner. Hence, they are not properly before us for consideration.

the appellants' counsel, Mr. Smith. Thus, for purposes of the appeal, claims 2-8 stand or fall with claim 1.

As indicated above, claim 1 stands rejected under 35 U.S.C. § 102(b) as being anticipated by Hussey.

Hussey discloses a "one-piece sealed disposable enema unit" (Abstract). The following passage from the reference describes the inventive unit in conjunction with a prior art unit:

FIG. 1 of the drawing shows a prior art disposable enema unit consisting of a plastic bottle 1 with a screw cap 2. Screw cap 2 has an elongated rectal tip 3 which is coated with a suitable lubricant. The rectal tip 3 has a cylindrical passage therein to allow passage of the enema fluid. The end of the rectal tip 3 has a constricted ring 7 which engages a finger 6 on protective sleeve 5. Before use, the user removes protective sleeve 5 by pulling upwards causing finger 6 to disengage from ring 7. The disposable enema unit shown in FIG. 1 is typically filled with sterile fluid. Since the engagement between finger 6 and ring 7 must be weak enough to permit easy removal of sleeve 5, as previously described, sleeve 5 often is disengaged during shipping or handling causing spillage of the enema fluid. Cap 2 has a restrictive diaphragm located in the screw on portion. The diaphragm is usually comprised of a resilient material having a slit therein to restrict passage of the enema fluid. When the unit is in use, external pressure on the bottle forces fluid past the diaphragm.

FIG. 2 of the drawing shows the inventive one-piece enema unit. It consists of a bottle portion 10 and a rectal tip 15. Rectal tip 15 and portion 10 may be molded in one piece or may be separate pieces which are joined by suitable and conventional means (such as adhesives) after filling of the enema fluid.

At the top of rectal tip 15 is a break-off tab 20 consisting of a spherical ball 20 which is mounted on the top of rectal tip 15. Ball 20 is of such diameter so that it completely encloses the circular passage through tip 15 (not shown in FIG. 1) preventing spillage of the fluid. Ball 20 may be molded as part

of tip 15 with a suitable wall thickness to allow it to be easily removed by twisting. Ball 20 is provided with ears 22 and 24 to allow the ball to be gripped and removed.

During manufacture of the enema unit, tip 15 is coated with a suitable lubricant and a sleeve 30 is slid over the unit as shown in FIG. 3. This sleeve is formed of a heat-shrinkable plastic material which is then heated to the shrinking temperature by conventional means causing it to conform to the ball and rectal tip as shown in FIG. 4. After sleeve 30 has become heat shrunk it is effectively fixed to ball 20 and thereby to the rectal tip 15. Sleeve 30 therefore protects the lubricant against contamination while ball 20 prevents contamination of the sterile enema fluid [column 2, line 49, through column 3, line 26].

Anticipation is established only when a single prior art reference discloses, expressly or under principles of inherency, each and every element of a claimed invention. RCA Corp. v. Applied Digital Data Sys., Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984). It is not necessary that the reference teach what the subject application teaches, but only that the claim read on something disclosed in the reference, i.e., that all of the limitations in the claim be found in or fully met by the reference. Kalman v. Kimberly Clark Corp., 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), cert. denied, 465 U.S. 1026 (1984).

The examiner's determination (see pages 3 and 4 in the answer) that the subject matter recited in claim 1 is anticipated by Hussey's one-piece sealed enema unit is well founded. The limitations in the claim pertaining to the flexible chamber,

sterile solution, non-invasive nozzle, protective tip and removable packaging read on Hussey's bottle portion 10, sterile fluid, tip 15, break-off tab 20 and heat-shrunk sleeve 30, respectively.

Notwithstanding the appellants' arguments to the contrary, the limitations in the claim defining the dispenser as "one-piece," "non-invasive," "for the rapid irrigation and debriding of wounds and incisions" and "disposable in any container" fail to distinguish the structure set forth in the claim from that disclosed by Hussey. To begin with, the Hussey unit is "one piece" to the same extent that the appellant's dispenser is,² and indeed Hussey expressly describes the unit as such. Furthermore, within the context of the claim, the "non-invasive," "irrigation and debriding" and "disposable in any container" recitations merely set forth the manner in which the dispenser is intended to be used. It is well settled, however, that the recitation of a new intended use for an old product does not make a claim to that old product patentable. In re Schreiber, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997). In this vein, the mere recitation of a newly discovered function or property, inherently

² Based on the underlying specification (see page 1), we understand the limitation "one-piece" to mean that the components of the dispenser are packaged in pre-assembled condition.

possessed by things in the prior art, does not cause a claim drawn to those things to distinguish over the prior art. In re Swinehart, 439 F.2d 210, 212, 169 USPQ 226, 229 (CCPA 1971). The appellants have failed to cogently explain, and it is not apparent, why the Hussey dispenser is not inherently capable of being used in the manner specified in claim 1.

Finally, the appellants' observation that their invention does not require the lubrication, break-off tab and/or other components of the Hussey unit is of no moment because claim 1 does not exclude, and is not otherwise inconsistent with, such additional features.

Thus, the appellants' position that the subject matter recited in claim 1 distinguishes over that disclosed by Hussey is not persuasive. Consequently, we shall sustain the standing 35 U.S.C. § 102(b) rejection of claim 1 as being anticipated by Hussey.

As claims 2-8 stand or fall with claim 1, we also shall sustain the standing 35 U.S.C. § 102(b) rejection of claims 3-5 as being anticipated by Hussey, the standing 35 U.S.C. § 103(a) rejection of claim 2 as being unpatentable over Hussey in view of Reddick, the standing 35 U.S.C. § 103(a) rejection of claim 6 as being unpatentable over Hussey in view of Rose, and the standing

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35 U.S.C. § 103(a) rejection of claims 7 and 8 as being unpatentable over Hussey in view of Wallace.

SUMMARY

The decision of the examiner to reject claims 1-8 is affirmed.

AFFIRMED

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

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Administrative Patent Judge

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